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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,616	11/20/2003	Henricus A. Marquering	0142-0436P	6357
2292 7590 11/06/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
SETH MANAV				
ART UNIT		PAPER NUMBER		
2624				
NOTIFICATION DATE		DELIVERY MODE		
11/06/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/716,616

**Applicant(s)**

MARQUERING ET AL.

**Examiner**

MANAV SETH

**Art Unit**

2624

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-21 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-17, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Response to Amendment after final

1. Applicant's amendment filed after final on October 15, 2008 has been considered and entered in full.
2. Applicant's arguments with respect to amended claims have been considered and are persuasive, therefore all prior art rejections on the respective claims have been withdrawn. The finality of the previous office action mailed has been withdrawn and the new rejections on the respective claims under 35 USC 101 have been presented below.

### *Drawings*

3. The specification in paragraph [032] discloses "Figure 1 shows an overview of an exemplary segmentation method showing three basic steps from **known segmentation systems**" and therefore, Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Official Gazette notice of 22 November 2005 <<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/og200547.htm>>), Annex IV, reads as follows:

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

5. Claims 14-17 and 23 are rejected under 35 U.S.C. 101 because:

Claims 14-17 and 23 are drawn towards a computer-program product embodied on at least one computer readable. Such computer executable programs are functional descriptive material that can constitute statutory products when properly claimed in combination with a computer readable storage device that allows the functionality of the program to be realized. However, while the claim defines the program in combination with a "computer readable medium," the claim language is not limited to the use of tangible storage media in combination with the program. Specifically, the disclosure defines the computer readable medium as including storage media such as RAM, ROM, PROM, magnetic disc, optical disc, magneto-optical disc and a computer data signal (paragraph 0076 on page 17 of the specification). While RAM, ROM, PROM, magnetic disc, optical disc, magneto-optical disc (statutory media) are physical storage devices, but a signal is intangible energy, and therefore is not considered to be a statutory product. While the claim does read on at least some statutory embodiments (such as the RAM, ROM, PROM, magnetic disc, optical disc, magneto-optical disc), it also encompasses the combination of the program with the signal, which is not a statutory product. Since the claimed invention encompasses non-statutory embodiments, the claim is directed towards non-statutory subject matter.

Claims 14-17 and 23 as a whole define a signal, and "[a] transitory, propagating signal ....is not a "process, machine, manufacture, or composition of matter." Those four categories define the explicit scope and reach of scope and reach of subject matter patentable under 35 U.S.C § 101; thus, such a signal cannot be patentable subject matter." (*In re Petrus A.C.M. Nutijen; fed Cir, 2006-1371, 9/20/2007*).

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible computer readable media such as "computer readable

storage medium”, while at the same time excluding the intangible media such as signals, carrier waves, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

6. Claims 1-7, 9-13 and 22 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

The memorandum issued can be found at:

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section\\_101\\_05\\_15\\_2008.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_101_05_15_2008.pdf)

Or,

from uspto.gov, click “Policy and Law”, “Patents”, “Memorandum to the Examining Corps”, “Clarification of “processes” under ... 101”.

### ***Allowable Subject Matter***

#### **Reasons of Allowance:**

7. Claims 18-21 and 24 are allowed.

The following is an examiner’s statement of reasons of allowance:

The reasons of allowance for claim 18 should be evident from the applicant's arguments as filed in the amendment filed on 10/15/2008. The closest prior art as cited does not teach "constructing separating elements corresponding to rectangular areas of adjacent pixels of the image having the background property" in combination with other limitations as recited in claim 18. Therefore claim 18 is allowed. All other claims depending on claim 18 are allowable at least by dependency on claim 18.

Claims 1-7, 9-17, 22 and 23 would be allowable for the same reasons as applied to claims 18-21 and 24, after all the 35 USC 101 rejection issues are resolved.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manav Seth whose telephone number is (571) 272-7456. The examiner can normally be reached on Monday to Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Bella, can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system,

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see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Manav Seth/  
Art Unit 2624  
November 1, 2008